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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/649,180	08/27/2003	Jay S. Walker	98-076-C1	5244

22927 7590 12/14/2004

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EXAMINER	
PIERCE, WILLIAM M	

ART UNIT	PAPER NUMBER
3711	

DATE MAILED: 12/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/649,180	WALKER ET AL.	
	Examiner	Art Unit	
	William M Pierce	3711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *27 August 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-33* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-3,8-11,13,17-21,26,27,32 and 33* is/are rejected.

7)☒ Claim(s) *4-7,12,14-16,22-25 and 28-31* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

WILLIAM M. PIERCE
PRIMARY EXAMINER

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *4*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-33 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-26 of U.S. Patent No. 6,676,126. Although the conflicting claims are not identical, they are not patentably distinct from each other because in the instant application, applicant has presented broader claims which, include no longer reciting the limitations of start and finish symbols. Hence this application claim is merely broader than the patent claim. Here, it is relied on the rationale in *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993). In essence, once the applicant has received a patent for a species or a more specific embodiment, he is not entitled to a patent for the generic or broader invention. This is because the more specific "anticipates" the broader. Drawing a helpful analogy, if you have a broad claim to examine, and you find a reference which discloses every element of the claim and more, you have a reference which anticipates. The same is true in an obviousness-type double patenting analysis where the claim being examined is merely broader than the claim patented before. The patented claim "anticipates" the application claim. The addition of a processor and a bar code, as called for in some of the independent claims are obvious methods of making and means for security known in the art of lottery cards.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 19-33 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims to mental steps such as "generating", "causing", "reading" and "outputting" or algorithms per se are not statutory subject matter under 35 U.S.C. 101. See MPEP 2106 IV B 1(a).

While the claims don't explicitly recite that they are a computer program, evidence that the applicant intends the "product" to be something other than a tangible medium is in claims 21 and claims 32 and 33 that recite download

to an electronic device or a processor respecitvely. Clearly, the applicant's independent claims 19 and 26 would embrace "software" or a computer program absent a tangible medium as required in *In re Beauregard, 35 USPQ2d 1383 (Fed. Cir. 1995).*

Merely claiming nonfunctional descriptive material stored in a computer-readable medium as called for in claims 21, 32 and 33 does not make the subject matter statutory. Such a result would exalt form over substance. *In re Sarkar, 588 F.2d 1330, 1333, 200 USPQ 132, 137 (CCPA 1978).*

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

Claims 1, 2, 10, 11, 19, 20 and 26 are rejected under 35 U.S.C. 102(b) as being anticipated by Dingledine.

As to claims 1, 10, 19, 20 and 26, Dingledine shows a plurality of symbols with links 5 where some of the adjacent symbols do not have a link between them. As to claims 2 and 11, the spaces of Dingledine are "printed" as being magnetic or non-magnetic. The non-magnetic spaces are considered "void symbols" to cause a non-continuous path as called for by the claim.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 3, 8, 9, 17, 18, 13, 21, 27, 32, 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dingledine in view of Kamille 5.092.598.

Dingledine does not show the use of a latex covering to hide his "void spaces". His game long predated the popularity of scratch off lottery tickets that are well known to use such coatings to make the games. See Kamille by way of example. To have used the latex covering to obscure the adverse spaces from a player instead of magnetism would have been obvious in view of Dingledine which disclosed spaces performing the same function as having an adverse effect on their selection by the player in the play of the game, albeit in a different environment Ryco, Inc. v. Ag-Bag Corp., 857 F.2d 1418, 8 USPQ2d 1323 (Fed. Cir. 1988). This rejection is based on replacing one known means of marking and obscuring an adverse playing space in a game with that of another. AS to claim 8, 9, 17, 18,

21, 27, 32 and 33, to have played a game like Dingledine's on a computer would have been an obvious matter of making a known game into a computer embodiment.

Conclusion

Claims below would be allowable if rewritten to include all of the limitations of the base claim and any intervening claims.

Dingledine fails to associate a prize with a continuous path as called for in claims 4-7, 14-16, 22-25, 28-31. Bar codes in each node as called for in claims 12 is not fairly taught.

Any inquiry concerning this communication and its merits should be directed to William Pierce at E-mail address bill.pierce@USPTO.gov or at telephone number (571) 272-4414.

For **official fax** communications to be officially entered in the application the fax number is (703) 872-9306.

For **informal fax** communications the fax number is (703) 308-7769.

Any inquiry of a general nature or relating to the **status** of this application or proceeding can also be directed to the receptionist whose telephone number is (703) 308-1148.

Any inquiry concerning the **drawings** should be directed to the Drafting Division whose telephone number is (703) 305-8335.

WILLIAM M. PIERCE
PRIMARY EXAMINER